

ARGUMENTS/REMARKS

Applicants would like to thank the examiner for the careful consideration given the present application. The application has been carefully reviewed in light of the Office action, and amended as necessary to more clearly and particularly describe and claim the subject matter which applicants regard as the invention.

The examiner objected to claims 5 and 33 because of informalities. Claims 5 & 33 have been amended to address the Examiner's concerns, making the objection moot.

Claims 1-39 were rejected under 35 U.S.C. §103(a) as being unpatentable over Shapiro (U.S. 5,705,980) in view of Balachandran (U.S. 6,073,004). For the following reasons, the rejection is respectfully traversed.

Claim 1 recites a method for distributing an emergency call message within a telecommunication network such that an emergency call message generated by a mobile user is "automatically sent first to mobile devices in the vicinity of the mobile user" and then "distributed to terminals, predefined by said user, in the telecommunication network". Claim 39 recites similar limitations at lines 6-9. New claims 40-45 also recited similar limitations. The combination of references does not teach these elements of these claims.

The Examiner cites Shapiro as teaching automatically sending an emergency call message to mobile devices in the vicinity of the mobile user. However, Shapiro teaches a dedicated emergency notification device for sending an emergency call message to *security* or *police officers* assigned to protect a given area (see col. 5, line 61 to col. 6, line 27), and does *not* suggest sending the message to *mobile devices* that are *in the vicinity* of the user. Thus, Shapiro does *not* notify other device users that may be *closer* to the emergency. Instead, Shapiro only notifies *security* personnel. There is no guarantee that these security personnel are in a vicinity of the user. Instead, it is likely that these security personnel are widely spaced, and thus *not* in a vicinity of the user. In contrast, the invention as recited in claims 1 & 39 specifically notifies other users in a *vicinity* of the device (likely near the emergency). Hence, making it more likely that a person nearby is notified of the emergency, and can come to the aid of the user. Balachandran does not overcome this shortcoming of Shapiro. Thus, claims 1 & 39 are patentable over the combination of references, as are new claims 40-45.

The Examiner cites Balachandran as teaching distributing the emergency call message to terminals, predefined by the user, in the telecommunication network. However, the claim

requires that the emergency message **first** be sent to devices in a vicinity of the user, and only **then** distributed to terminals predefined by the user. There is a temporal limitation of one event occurring before the other.

Thus, even if Balachandran is combined with Shapiro, there is no suggestion in either reference of the temporal relationship defined by the claim. There is nothing to suggest that the emergency message be sent to devices in a vicinity of the user **first**, and **then** distributed to terminals predefined by the user. Thus, the references, even if combined, do not teach all of the limitations of the claim, as required by MPEP §2143.03. Thus, for this reason as well, claims 1 & 39 and new claims 40-45 are patentable over the references, even if combined.

Claim 37 recites an "identification module" for the mobile terminal with a memory area for a "list of terminals predefined by the mobile user and to which emergency call messages must be sent". Claim 5, and new claims 41, 43 & 45 have similar limitations. The Examiner cites Shapiro as teaching this element these claims. However, a close reading of Shapiro does not support this interpretation of the reference.

The cited passages in Shapiro teach that information such as a unit's digital code is indexed with a person's identity and stored in memory at the security station 12 (col. 3, lines 11-16). Further, an image of the person's face might be stored in digital form at the security station 12 (col. 3, lines 16-20). However, figure 1 makes clear that the security station 12 is not part of any mobile terminal. Instead, the security station 12 is part of a paging facility 16, has video display terminal 18 and a keyboard, and is thus not a mobile device (see col. 2, lines 10-15). Balachandran does not overcome this Shapiro shortcoming.

Consequently, this element of claims 5, 37, 41, 43, & 45 are patentable over the references, even if combined.

All remaining claims in the case, which depend, directly or indirectly, on one of the independent claims discussed above, are all patentable over the references for the reasons discussed for the parent claims, and for the limitations contained therein.

Further, the Examiner has not supported a *prima facie* case for combining the references. The burden is on the Examiner to make a *prima facie* case of obviousness (MPEP §2142). To support a *prima facie* case of obviousness, the Examiner must show that there is some *suggestion* or *motivation* to modify the reference(s) (MPEP §2143.01). The mere fact that references *can* be combined or modified, alone, is not sufficient to establish *prima facie* obviousness (*Id.*). The prior art must also suggest the *desirability* of the combination (*Id.*). The fact that the claimed invention is within the *capabilities* of one of ordinary skill in the art

is not sufficient, by itself, to establish prima facie obviousness (*Id.*).

The Examiner has not cited any proper motivation for the combining the references from any citation within the references, and neither does the Examiner provide any other references supporting any motivation to modify the reference(s) by making the combination. A conclusory statement of benefit, such as the one provided by the Examiner in the Office action, is not sufficient to show obviousness, because merely listing an advantage of the combination is not sufficient, as some rationale for combining the references must be found in the references themselves, or drawn from a convincing line of reasoning based on established scientific principles practiced by one skilled in the art that some advantage or beneficial result would be produced by the combination (MPEP §2144). Such motivation cannot be found in the application itself, as such hindsight is impermissible; the facts must be gleaned from the prior art. (MPEP §2142, last paragraph).

Accordingly, the Examiner has not supported a prima facie case of obviousness, and thus the rejection cannot stand.

Finally, the applicant traverses the Examiner's application of "official notice" as applied in the Office action. Accordingly, applicant formally requests, as required by the MPEP §2144.03, that the Examiner locate a reference in support of his positions.

In consideration of the foregoing analysis, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 16-0820, our Order No. 34378.

Respectfully submitted,

PEARNE & GORDON, LLP

By: 

Robert F. Bodi, Reg. No. 48,540

526 Superior Avenue, East
Suite 1200
Cleveland, Ohio 44114-1484
(216) 579-1700

June 16, 2003